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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,286	07/07/2000	Julio A. Abusleme	108910-00011	8395

7590

05/01/2002

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EXAMINER

SHOSHO, CALLIE E

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 05/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**DETAILED ACTION**

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 2/19/02.

**Claim Objections**

2. Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 6, which depends on claim 1, recites that the temperature is in the range of 0<sup>0</sup>-150<sup>0</sup> C and pressure of 3-80 bar. However, claim has been amended to recite this exact limitation. Thus, claim 6 has improper dependent form because it does not further limit claim 1 but rather recites limitation identical to that found in claim 1. Should claim 6 be cancelled?

**Claim Rejections - 35 USC § 112**

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Newly added claim 10, which depends on claim 1 or 9, recites, "wherein  $M^+$  is  $K^+$ ".

However, the scope of the claim is confusing given that neither claim 1 nor claim 9 recites " $M^+$ ".

**Claim Rejections - 35 USC § 102**

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-7 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Abusleme et al. (U.S. 5,498,680).

The rejection is adequately set forth in paragraph 4 of the office action mailed 8/17/01, Paper No. 6, and is incorporated here by reference.

Additionally, with respect to newly added claim 9, it is noted that col.5, lines 47-48, 51-52, and 55-56 disclose that the fluorinated monomers polymerized include perfluorinated monomers.

**Claim Rejections - 35 USC § 103**

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1-6 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone et al. (U.S. 5,672,667) in view of Abusleme et al. (U.S. 5,498,680).

# Office Action Summary

Application No.

09/612,286

Applicant(s)

ABUSLEME ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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The rejection is adequately set forth in paragraph 8 of the office action mailed 8/17/01, Paper No. 6, and is incorporated here by reference.

Additionally, with respect to newly added claim 9, it is noted that col.3, lines 57-58 and col.4, lines 19-22 disclose that suitable comonomers include perfluorinated monomers.

### **Response to Arguments**

9. Applicants' arguments regarding Abusleme et al. (U.S. 6,096,795) and Wu et al. (U.S. 6,046,271) have been fully considered but they are moot in view of the discontinuation of these references as applied the present claims.

10. Applicants' arguments filed 2/19/02 have been fully considered but they are not persuasive.

Specifically, applicants argue that:

(a) Abusleme et al. do not teach the present invention.

(b) Comparative data in the present specification establishes criticality over Abusleme et al. with respect to present claimed initiators.

(c) No motivation to combine DeSimone et al. with Abusleme et al. given that DeSimone et al. disclose the polymerization of fluorinated monomers in an aqueous emulsion in the presence of CO<sub>2</sub>.

With respect to argument (a), it is the examiner's position that given that Abusleme et al. disclose a polymerization process of one or more fluorinated monomers which include

chlorotrifluoroethylene and perfluorinated monomers in the presence of microemulsion of fluoropolyoxypolyalkylenes, fluorinated surfactant, and initiator as presently claimed, Abusleme et al. does in fact disclose the present invention.

Although there are no examples which teach the polymerization of chlorotrifluoroethylene, "applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others." *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). Further, although chlorotrifluoroethylene (co)polymer as presently claimed is not listed in the preferred polymers formed in Abusleme et al. (col.5, line 65-col.6, line 49), "nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims," *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). Col.5, lines 41-42 and 54 disclose that the polymers obtained from the process of Abusleme et al. include those formed from chlorotrifluoroethylene as presently claimed.

With respect to argument (b), it is noted that Abusleme et al. disclose the use of initiators which include alkali metal persulfates and ammonium persulfates. The comparative data in the present specification compares invention within the scope of the present claims, i.e. utilizing potassium persulfate (example 1), with invention outside the scope of the present claims, i.e. comprising ammonium persulfate (example 5). It is shown that the process of the present invention produces chlorotrifluoroethylene polymer with no discoloration while the comparative process produces a chlorotrifluoroethylene polymer which is discolored.

However, it is noted that the present claims are not rejected as being obvious over the cited art, but rather are anticipated over the prior art. Given that Abusleme et al. already disclose the use of initiator as presently claimed, the results of the comparison in the declaration are not believed to be unexpected or surprising.

Additionally, as cited in MPEP 706.02(b), it is noted that a rejection based on 35 USC 102(b), such as Abusleme et al., can only be overcome by (a) persuasively arguing that the claims are patentably distinguishable from the prior art, (b) amending the claims to patentably distinguish over the prior art, or (c) perfecting priority under 35 USC 119(e) or 120. As can be seen, comparative data is not sufficient to overcome an anticipatory rejection under 102(b).

With respect to argument (c), applicants argue that there is no motivation to combine DeSimone et al., which discloses the polymerization of fluorinated monomers in the presence of an aqueous emulsion, fluorinated surfactant, and initiator, with the fluoropolyoxyalkylene microemulsion of Abusleme et al.

However, given that Abusleme et al. disclose that the addition of a fluoropolyoxyalkylene microemulsion to an aqueous emulsion results in increased reaction rates and a reduction of the working pressure, it is the examiner's position that there is motivation to combine DeSimone et al. with Abusleme et al.

Further, applicants argue that the process of DeSimone et al. requires the use of CO<sub>2</sub> which is not required in the present claims. However, in light of the open language of the present claims, i.e. "a reaction medium comprising", it is clear that the reaction medium is open to the inclusion of other ingredients including CO<sub>2</sub>.

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11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

C.S.

Callie Shosho  
April 30, 2002

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